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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,226	03/26/1999	ISABELLE BARA	05725.0362-0	3233

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EXAMINER

WELLS, LAUREN Q

ART UNIT PAPER NUMBER

1617

DATE MAILED: 04/03/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 27 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** (check either a) or b))

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 February 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

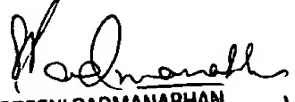
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1,3-19,23,25-29,35,40,42-57,59,60 and 62-66.Claim(s) withdrawn from consideration: 20-22, 24, 30-39, 41, 58, 67.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

3/28/03

Continuation of 5. does NOT place the application in condition for allowance because: a) the 35 USC 112, 102, and 103 rejections are maintained for reasons of record in the Office Action mailed 8/27/02, Paper No. 24; b) Applicant's arguments over the 112 and 102 rejections are moot, as the arguments are directed to the After Final Amendment that is not being entered; c) Regarding the 103 rejection, Applicant argues, "EP '661 does not teach or suggest that the silicones disclosed therein could be substituted with an alpha, omega-substituted oxyalkylenated silicones. . . In fact, EP '661 teaches away from such a substitution when it states that it is 'very difficult to obtain a highly stable water-in-oil type emulsion cosmetic which comprises a silicone oil as a base'". This argument is not persuasive. EP '615 teaches the oxyalkenated silicones as having superior properties, such as rheological flow behavior and as forming a lamellar phase structure to maintain the suspension of water-insoluble particles. Furthermore, it is respectfully pointed out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Applicant argues, "One of ordinary skill in the art would not have been motivated to substitute elements of these compositions, intended for two different and completely incompatible uses". This argument is not persuasive. The Examiner respectfully points out that both prior art references are directed to cosmetic products comprising oxyalkenated silicones. Thus, one of skill in the art would be motivated to look to references teaching other oxyalkenated silicones with superior cosmetic properties to substitute for those in the primary reference. .